

Applicant: Troudt
Serial No.: 10/635,953
Filed: 08/07/2003
Title: EXTENSION POLE WITH SWIVEL SPRAY NOZZLE
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IN THE DRAWINGS

FIG. 2 and FIG. 11 have been amended to add designating numerals 9, and 80-83, a copy of which is provided herewith.

REMARKS

FIG. 11 has been amended to add new designating numerals as previously indicated.

Claims 9, 11, 12 and 14-37 are allowed; claims 2, 3 and 5 are rejected.

Claim 2 has been amended to require that the hand grip further comprise a grip portion adapted to receive a user's hand with the pole slidably passing through the grip portion. The specification has also been amended to clarify this feature. Authority for this amendment is found in FIG. 2.

Claim 3 has been amended to require that the hand grip rearward, that is toward the pole proximal end, of a connection of the rod to the hand grip is without an obstruction extending therefrom that might impede said operator's hand from grasping the hand grip around the grip portion. The specification has also been amended to clarify this feature. Authority for this amendment is also found in FIG. 2.

Claim 5 has been amended to require that the rod pivotably connect to a lug at a lug distal end spaced apart from said axis with a lug proximal end affixed to the hand grip such that as the hand grip rotates on its axis, the lug also rotating with a rod end pivoting in the lug distal end as the lug distal end moves forward toward the pole distal end or rearward toward the pole proximal end. The specification has also been

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amended to clarify this feature. Authority for this amendment is found in FIG. 11.

The examiner rejected claims 2-3 as being unpatentable under 35 U.S.C. 103(a) over U.S. Pat. 2,857,201 to Palmer. Palmer discloses a slide with a pole portion through which a pole with a swivel nozzle passes and further comprising a pistol-style handgrip on the slide extending radially from the slide pole portion. The pistol-style handgrip on the slide pole portion obstructs an operator's hand from grasping the slide pole portion through which the pole passes. Hence, Palmer does not disclose the limitations of amended claim 2 and 3, which requires that the pole passes slidably through the grip portion without obstructions extending therefrom.

Claim 5 has been amended to require that the rod pivotably connect to a lug at a lug distal end spaced apart from the axis of rotation of the handgrip with a lug proximal end affixed to the hand grip such that as the hand grip rotates on its axis, the lug also rotates with a rod end pivoting in the lug distal end as the lug distal end moves forward toward the pole distal end or rearward toward the pole proximal end. Neither Palmer nor Louge nor their combination discloses a rod in pivoting connection to the handgrip.

The examiner has rejected claim 5 as being unpatentable under 35 U.S.C. 103(a) over Palmer in view of U. S. Patent 4,323,196 to Louge et al. Applicant traverses the examiner's basis for combining these two references.

To establish obviousness, two requirements must be shown: First, a suggestion, teaching or motivation to modify the reference or combine the prior art references must be shown. Yamanouchi, 231 F.3d at 1341

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(citing *In re Longi*, 759 F.2d 887, 896 (Fed.Cir.1985)); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed.Cir.2000) (quoting *C.R. Bard, Inc. v. M3 Systems Inc.*, 157 F.3d 1340, 1352 (Fed.Cir.1998)); *Ortho Pharm. Corp. v. Smith*, 959 F.2d 936, 942 (Fed.Cir.1992). The Federal Circuit has stressed the importance of this showing: "[V]irtually all [inventions] are combinations of old elements.... Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability very few patents would ever issue.... To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness." *Rouffet*, 149 F.3d at 1357-58 (internal quotations and citations omitted). Broad conclusory statements, standing alone, are insufficient. *In re Dembiczak*, 175 F.3d 994, 999 (Fed.Cir.1999), abrogated on other grounds by *In re Gartside*, 203 F.3d 1305 (Fed.Cir.2000). Rather, evidence of motivation or suggestion to modify a reference or combine it must be "clear and particular." *Dembiczak*, 175 F.3d at 999; see *Brown & Williamson Tobacco*, 229 F.3d at 1125. Second, it must be shown that one of ordinary skill in the art would reasonably expect that so combining or modifying the prior art references would achieve success. *Id.* It is respectfully submitted that the examiner has not presented "clear and particular" evidence but rather resorted to a broad unsupported conclusory statement that fails to meet the required burden to show obviousness by combination of references.

The examiner states that one skilled in the art would be motivated to combine these references to provide a stabilizing hand-brace on the

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device. Applicant responds that each of these references alone already discloses a device that provides a stabilizing hand-brace without combination. Clearly, it is not required to combine them to obtain such a device and no improvement in stabilization results from doing so. There is no teaching, suggestion, or motivation found either in the references or in the knowledge generally available to one of ordinary skill in the art or to combine these references to obtain a stabilized hand-brace on the pole . See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Because the examiner's basis for combination as stated fails, the combination of these references is inappropriate and should be withdrawn.

Combination of the two references also fails in that there could be no reasonable expectation of success. Palmer's primary inventive feature is a sliding handhold. To require it to not slide is in derogation of its primary feature. If the Palmer handhold did not slide the device would be dysfunctional. A combination of features of references that renders the resulting device dysfunctional cannot be heard to suggest their combination. Further, the Louge rotatable handgrip does not admit of a rod connecting between the swivel nozzle and the handgrip but requires a pulley apparatus to match the pulley apparatus at its swivel nozzle. There is no mechanism on the Louge device for connection and actuation of a rod upon rotation of the louge hand grip. Nor is there a mechanism on Palmer for actuation of the rod longitudinal motion by rotation of a handgrip in substitution of a sliding handgrip. And their combination continues to lack such a mechanism that gives effect to the rod. Because these two references cannot be combined without added inventive

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contribution, their combination is inappropriate and should be withdrawn.

The examiner appears to be employing impermissible hindsight to construct applicant's device from elements of Palmer and Louge. Of course, any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). But because knowledge suggesting such a combination or motivation for such a combination was not within the level of ordinary skill at the time the applicant's invention was made but was instead gleaned only from the applicant's disclosure, such a reconstruction is proper. (*Id.*) Merely extracting an element from Louge - the rotating handgrip - on a piecemeal basis to arrive at Applicant's device, even to the exclusion of other parts of Louge that give full appreciation to what Louge fairly suggests to one of ordinary skill in the art is not permissible. One cannot approach the obviousness inquiry on a piecemeal basis, arguing that the separate elements of applicant's invention existed in the prior art. "[A]bsent some teaching or suggestion, in the prior art, to combine the elements," however, this is "insufficient." *Arkie Lures*, 119 F.3d at 957; see also *Ruiz*, 234 F.3d at 665; *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosure in the prior art to deprecate the claimed invention."); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549 (Fed.Cir.1983). As the Federal Circuit has explained, "[t]hat all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil*

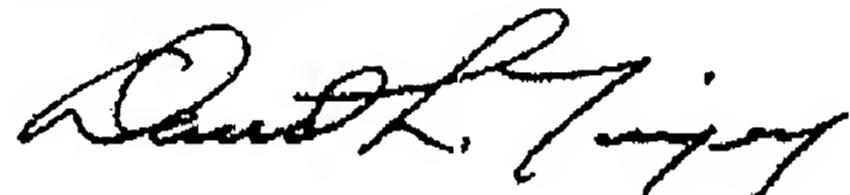
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Co. of California, 713 F.2d 693, 698 (Fed.Cir.1983). Combination of separate elements of applicant's invention existing in other devices requires clear evidence and particular evidence justifying their combination, which evidence is wholly lacking in this instance.

Dated: May 6, 2005

For Applicant, Troudt

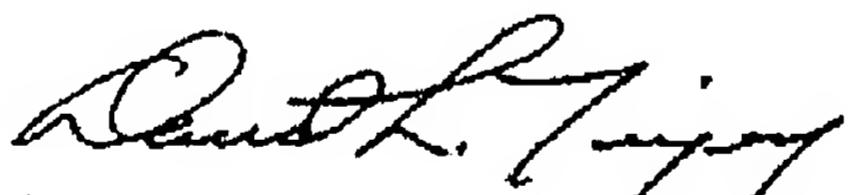
Respectfully,



David L. Tingey
Attorney for Applicant
Reg. No. 32,315
Customer 27408

CERTIFICATE OF FACSIMILE TRANSMISSION

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David L. Tingey
Attorney for Applicant
Reg. No. 32,315